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09/653,095	08/31/2000	Heath B. Clarke	ELIBER.001A	4070

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Knobbe Martens Olson & Bear LLP  
2040 Main Street  
Fourteenth Floor  
Irvine, CA 92614

EXAMINER
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RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/653,095

Applicant(s)

CLARKE, HEATH B.

Examiner

Rob Rhode

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

The office action of 03-17-03 rejected claims 1 – 3, 6, 7 and 25 as anticipated by Sanford. Claims 4, 5, 8 and 14 were rejected as unpatentable over Sanford in view of Axaopoulos and claims 9 – 13, 19 and 20 were rejected as unpatentable over Sanford in view of Axaopoulos and further in view of Shkedy. Claims 15- 18 and 22 – 24 were rejected as unpatentable over Sanford in view of Axaopoulos and further in view of Scroggie and remaining claim 21 was rejected as being unpatentable over Sanford in view of Scroggie.

Applicant amendment of 9-25-03 amended claim 4 as well as traversed rejections of Claims 1 - 25.

Currently, claims 1- 25 are pending.

### ***Response to Arguments***

Applicant's arguments filed 9/11/2003 have been fully considered but they are not persuasive.

Examiner's Note: Examiner has cited particular columns and line numbers as well as Figure's in the references as applied to the claims below for the convenience of the applicant. Although the specified citations and Figures are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the

applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

In this case, Applicant first argues - that Sanford does not recognize the problems associated with providing *product* (italics added for emphasis) information such as "a method of providing access to information relating to a plurality of products using a cascading commerce menu". Second, applicant argues that since Sanford fails to disclose and is not concerned with products there would be no motivation to combine Sanford and Axaopoulos and that Axaopoulos (Figure 22) does not teach a method including rankings based on aggregated price. Third, the applicant argues regarding claim 21 that there would be no motivation to combine Stanford with Scroggie and Scroggie is primarily directed to providing shopping incentives.

0 In response to the applicant's first argument, Sanford does provide and solve the problem associated with access at a web site and providing such as product information/categories. As the applicant's Abstract cite - "A cascading commerce menu provides access to a plurality of product, service, and/or content categories", Sanford does provide this method, system and computer medium for a left-to-right cascading commerce menu - comprising titles of the web site's web pages and links to the titled pages (see at least Abstract), which can include products. With this method and system, an individual using an online site - whether it is for products or content will be provided

a user friendly method for site navigation, which will simplify access to complex and detailed information such as product, service and/or content. Moreover and while Figure 7 was referenced, it is a pictorial example – and an example of a cascading commerce menu that could just as well addressed product. The method, system and computer medium of Sanford is not limited to content and therefore is capable of providing a first level menu and detecting a cursor over a first product (i.e. information) category and providing a second level cascading menu (see at least Col 2, lines 30 – 34).

Furthermore, online methods and systems such as a cascading commerce menu's for identifying, detecting and providing product, service and/or content that a kind/type including such specifics as "product" is given little patentable weight. The phrase(s) and or word(s) are given little patentable weight because the claim language limitation is considered to be non-functional descriptive material, which does not patentably distinguish the applicant's invention from Sanford. Thereby, the non-fictional descriptive material is directed only to the content of the information (product – which could also be service and/or content of the site) and therefore does not affect either the structure or method/process of Sanford, which leaves the method and system unchanged.

0 In response to applicant's second argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Sanford as addressed above – does provide a method and system for providing information at an online site through a cascading commerce menu and therefore any claims depending from claim 1 also stand rejected as well as arguments relative to dependent claims are consider moot. However Stanford and when combined with Axaopoulos, does address the arguments regarding claim 8. For example, the Axaopoulos reference does disclose a method for “ranking based on aggregated price of an item” (see at least Abstract and Figures 22 and 24). Aggregated price includes and as defined by Webster’s Dictionary as “the whole or amount: SUM TOTAL”. In that regard, Axaopoulos does provide a ranking based on aggregated price and further it is implicit that an individual as well as dealer would have included in all cost (see Figure 22 and in particular the items included such as Saturn: SL2 –. i.e. “a first additional cost”).

0 In response to applicant's third argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Sanford as addressed above re argument one – does provide a method and system for providing

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addressed above re argument one – does provide a method and system for providing information at an online site through a cascading commerce menu. Moreover, the added limitation of providing a “reward to the customer at least partly in response to the customer’s selection of said first subset of product categories” is fully addressed by Scroggie. For example and as defined by Webster’s Dictionary a reward is “ something that is given in return for good or evil done or received and esp. that is offered or given for some service or attainment”. In that regard, Scroggie does provide an incentive (i.e. reward) for attainment “partly in response to the customer’s selection” (see at least Col 4, lines 4 – 16).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1 – 3, 6, 7 and 25 are rejected under 35 U.S.C. 102(e) as being unpatentable over Sanford et al (US Patent 6,256,028 B1).**

Regarding Claim 1 and related Claim 25, Sanford teaches a method and system of providing access to information relating to a plurality of products using a cascading commerce menu, comprising - providing a first level menu listing a first set of product categories (Abstract and Figure 7); detecting a position of a cursor over a first product category listed in said first set of product categories (Col 7, lines 11 – 13 and Figure 7); and providing a cascading second level menu listing a first set of product subcategories related to said first product category in response to said detection of said cursor position (Col 7, lines 11 – 13 and Figure 7).

Regarding Claim 2, Sanford teaches a method, wherein said cascading menu is stored on a client computer (Col 5, lines 57 – 67 and Figure 5).

Regarding Claim 3, Sanford teaches a method, wherein at least one of said listed first set of product categories provides a link over the Internet to a commerce site (Col 6, lines 66 – 67 and Figure 7).

Regarding Claim 6, Sanford teaches a method as defined, wherein the cascading menu is dynamically generated from text, and where the text is stored on a client computer (Col 2, lines 38 – 42).

Regarding Claim 7, Sanford teaches a method, wherein the dynamically generated cascading menu is updated, further comprising - receiving an indication of a version of



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the text stored on the client computer (Col 2, lines 35 – 44); transmitting changes to be applied to the text stored on the client computer (Col 2, lines 35 – 44); updating the text stored on the client computer using the transmitted changes (Col 2, lines 35 – 44); and dynamically generating the cascading menu from the updated text (Col 2, lines 35 – 51 and Figure 7).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 4, 5, 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanford (US Patent 6,256,028 B1) in view of Axaopoulos (US Patent 6,286,022 B1).**

Sanford discloses and teaches a method – including related portions of Claim 14 addressed and referenced previously in this office action of providing access to information relating to a plurality of products using a cascading commerce menu, comprising - providing a first level menu listing a first set of product categories; detecting a position of a cursor over a first product category listed in said first set of

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product categories; and providing a cascading second level menu listing a first set of product subcategories related to said first product category in response to said detection of said cursor position. In addition, Sanford discloses and teaches a method, wherein the dynamically generated cascading menu is updated, further comprising - receiving an indication of a version of the text stored on the client computer; transmitting changes to be applied to the text stored on the client computer; updating the text stored on the client computer using the transmitted changes; and dynamically generating the cascading menu from the updated text.

On the other hand, Sanford does not specifically disclose and teach a method further comprising automatically generating a search string based on said first category and said first subcategory – as well as providing a display of a plurality of products from multiple vendors, where the plurality correspond to the search string. Nor does Sanford specifically disclose and teach further including ranking providers based on an aggregate price of an item available from the providers wherein the item corresponds to the first product category and the first product subcategory, the method comprising - receiving a first item price for said item from a first provider; receiving a first additional cost associated with providing the item by said first provider to a first consumer; receiving a second item price for said item from a second provider; receiving a second additional cost associated with providing the item by said second provider to said first consumer; and ranking said first provider and said second provider based on at least

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said first item price, said second item price, said first additional cost, and said second additional cost.

However and regarding Claim 4, Axaopoulos teaches a method, further comprising automatically generating a search string based on said first category and said first subcategory (Col 3, lines 16 – 30 and Col 11, 32 – 67)

Regarding Claim 5, Axaopoulos teaches a method, further comprising providing a display of a plurality of products from multiple vendors, where the plurality corresponds to the search string (Figure 22).

Regarding Claim 8, Axaopoulos teaches a method, further including ranking providers based on an aggregate price of an item available from the providers wherein the item corresponds to the first product category and the first product subcategory, the method comprising - receiving a first item price for said item from a first provider (Figure 22); receiving a first additional cost associated with providing the item by said first provider to a first consumer (Figure 22); receiving a second item price for said item from a second provider (Figure 22); receiving a second additional cost associated with providing the item by said second provider to said first consumer (Figure 22); and ranking said first provider and said second provider based on at least said first item price, said second item price, said first additional cost, and said second additional cost (Figure 22).

Regarding Claim 14, Axaopoulos teaches a method of automatically generating a search request based at least in part on said customer selection of said relatively narrower product category (Col 3, lines 16 - 32); and providing the customer with information on products related to said selected relatively narrower product category at least partly in response to said search request (Col 17, lines 1 –3 and Figure 22).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method of Sanford with the method of Axaopoulos to have enabled the capability of automatically generating a search string based on said first Category and said first subcategory as well as providing a display of a plurality of products from multiple vendors, where the plurality correspond to the search string – in order to ease the burden on the shopper to search the web for items highlighted/selected and being provided with ranked, multiple bidders. Thereby increasing their level of satisfaction as well as increasing the probability that they will return in the future to the web site for additional shopping needs as well as recommend the site to others.

**Claims 9 – 13, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanford (US Patent 6, 256,028 B1) in view of Axaopoulos (US Patent 6,286,002 B1) and further in view of Shkedy (US Patent 6,260,024).**

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The combination of Sanford and Axaopoulos discloses and teaches (Sanford teachings addressed and referenced above) a method of providing the capability of automatically generating a search string based on said first category and said first subcategory – as well as providing a display of a plurality of products from multiple vendors, where the plurality correspond to the search string. Additionally, the combination of Sanford and Axaopoulos specifically disclose and teach the ranking of providers based on an aggregate price of an item available from the providers wherein the item corresponds to the first product category and the first product subcategory, the method comprising - receiving a first item price for said item from a first provider; receiving a first additional cost associated with providing the item by said first provider to a first consumer; receiving a second item price for said item from a second provider; receiving a second additional cost associated with providing the item by said second provider to said first consumer; and ranking said first provider and said second provider based on at least said first item price, said second item price, said first additional cost, and said second additional cost.

On the other hand, the combination of Sanford and Axaopoulos does not specifically disclose and teach, wherein said first additional cost is a shipping, tax and insurance cost associated with the provision of said item from said first provider, and said second additional cost are these cost associated with the provision of said item from said second provider - as well as providing an auction capability.

However and regarding Claim 9, Shkedy teaches a method wherein said first additional cost is a shipping cost associated with the provision of said item from said first provider, and said second additional cost is a shipping cost associated with the provision of said item from said second provider (Col 17, lines 55 – 59).

Regarding Claim 10, Shkedy teaches a method, wherein said first additional cost is a tax associated with the provision of said item from said first provider, and said second additional cost is a tax associated with the provision of said item from said second provider (Col 17, 55 – 59).

Regarding Claim 11, Shkedy teaches a method, wherein said first additional cost is an insurance cost associated with the provision of said item from said first provider, and said second additional cost is an insurance cost associated with the provision of said item from said second provider (Col 17, lines 55 – 59).

Regarding Claim 12 and related Claim 19, Shkedy teaches a method, wherein an addition of said second item price and said second additional cost is lower than an addition of said first item price and said first additional cost, and where said second provider is ranked higher than said first provider (Col 7, lines 13 – 20).

Regarding Claim 13 and related Claim 20, Shkedy teaches a method, further comprising receiving a bid from said first provider to lower at least one of said item price

and said first additional cost to thereby improve the first provider's ranking (Col 26, lines 46 – 64).

It would have been obvious at the time of the invention to have provided the combination of Sanford and Axaopoulos with the method of Shkedy to have provided the capability wherein said first additional cost is a shipping, tax and insurance cost associated with the provision of said item from said first provider, and said second additional cost are these cost associated with the provision of said item from said second provider and providing an auction capability – in order to provide an even more robust capability in shopping for, and providing detailed information from several providers on requested products. As a result, this method will significantly ease the online shoppers efforts and increase their satisfaction with the web site and its stickyness features. Moreover, these capabilities will significantly increase the probability that the shopper will return to the web site more often for future shopping and buying, which will increase total sales for the site.

**Claims 15 – 18 and 22 - 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanford (US Patent 6, 256,028 B1) in view of Axaopoulos (US Patent 6,286,002 B1) and further in view of Scroggie et al (US Patent 6,185,541 B1).**

The disclosures and teachings of the combination of Sanford and Axaopoulos were previously addressed and referenced.

The combination of Sanford and Axaopoulos on the other hand do not disclose and teach a method further comprising providing the customer a reward or credit at least partly in response to using the cascading commerce menu as well as in response to customer purchasing a product – which can include an advertisement.

However and regarding Claim 15, Scroggie teaches a method, further comprising providing the customer a reward at least partly in response to using the cascading commerce menu (Col 3, lines 12 – 14)

Regarding Claim 16, Scroggie teaches a method, wherein the reward is a credit (Col 3, lines 12 – 14).

Regarding Claim 17, Scroggie teaches a method, further comprising providing the customer a reward in response to the customer purchasing at least one product associated with the selected relatively narrower product category (Col 3, lines 14 – 21).

Regarding Claim 18, Scroggie teaches a method, further comprising providing an advertisement on at least one of said first level menu and said cascading second level menu (Col 7, line 62).



Regarding Claim 22, Scroggie teaches a method, further comprising causing the display of an amount of the reward associated with a selection of a first subset of product categories (Col 7, lines 52 – 55).

Regarding Claim 23, Scroggie teaches a method, further comprising causing the display of the total rewards earned by the customer (Col 7, lines 52 – 55).

Regarding Claim 24, Scroggie does not teach a method, further comprising - providing a referral award in response to the customer causing others to download said cascading menus; and causing the display of the referral reward amounts earned by the customer. Official Notice is taken that both the inventive concept and the advantage of providing a referral award method for customers are well known and expected in the art. Thus it would have been obvious to have provided the customer a referral method in order to not only increase customer satisfaction but also as importantly add additional shoppers to the site as result of this incentive.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Sanford and Axaopoulos with the method of Scroggie to enable the capability of providing the customer a reward or credit at least partly in response to using the cascading commerce menu as well as in response to customer purchasing a product – which can include an advertisement. In that regard,

the on line shopper is incented to continue using the web site more frequently for purchases in order to capture and use these cost reduction benefits – and too increasing the satisfaction of the customer as well as increasing their frequency of use in shopping.

**Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanford (US Patent 6,256,028 B1) in view of Scroggie (US Patent 6,185,541 B1).**

Previously in this office action, the details regarding what Sanford discloses and teaches were fully addressed and referenced – which also apply to the first four steps of Claim 21.

However, Sanford does not specifically disclose and teach providing a reward to the customer at least partly in response to the customer's selection of said first subset of product categories.

Regarding Claim 21, Scroggie does disclose and teach a method of providing a reward to the customer at least partly in response to the customer's selection of said first subset of product categories (Col 3, lines 12 – 14):

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method of Sanford with the method of Scroggie to enable the

capability of providing a reward to the customer at least partly in response to the customer's selection of said first subset of product categories – in order to provide the customer a reward or credit at least partly in response to using the cascading commerce menu as well as in response to customer purchasing a product – which can include an advertisement. In that regard, the on line shopper is incented to continue using the web site more frequently for purchases in order to capture and use these cost reduction benefits – and too increasing the satisfaction of the customer as well as increasing their frequency of use of the online site for shopping.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rhode whose telephone number is 703.305.8230. The examiner can normally be reached on M-F 7:30am - 4:00pm.

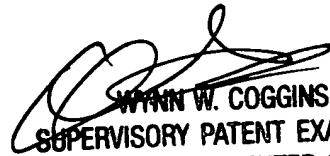
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 703.308.3588. The fax phone numbers for the organization where this application or proceeding is assigned are 703.872.9206 for regular communications and 703.872.9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.1113.

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